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| RONALD P KANANEN | | | NGUYEN, LUONG TRUNG | |
| RADER, FISHMAN & GRAUER P.L.L.C. | | | | |
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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUTAKA NAKATSU, SHIN IIMA, KAYOKO OHYOSHI,
and TOMOMI NAKAMURA

Appeal 2007-3585
Application 08/610,758
Technology Center 2600

Oral Hearing Held: April 10, 2008

Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY, and KEVIN F. TURNER, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

RONALD P KANANEN
RADER, FISHMAN & GRAUER P.L.L.C.
1233 20TH STREET, NW SUITE 501
WASHINGTON DC 20036

The above-entitled matter came on for hearing on Thursday, April 10, 2008, commencing at 10:47 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Deborah Rinaldo, RPR, Notary Public.

1 MR. DUTTON: Thank you and good morning.

2 JUDGE RUGGIERO: Want to spell your name for the reporter?

3 MR. DUTTON: Sure. It's Brian Dutton, D-U-T-T-O-N.

4 May it please the court, Brian Dutton arguing on behalf of
5 patentability of the claims at issue. I guess what I would like to do, I would
6 just like to amplify what I've already presented in the appeals brief and the
7 reply brief. And with this invention I think that there is really an interesting
8 way for the board to look at this when they take all the references together.

9 I would like for the board to take a look at the references and the
10 points where the examiner has cited and which are most relevant in our
11 opinion.

12 If you look at his main reference, Takahashi, that would be at figure
13 19 showing this overall general structure.

14 Then if you secondly lay that out next to this Uekane reference which
15 the examiner applies as a secondary reference, and if you have figure 3 of
16 that reference, they are showing the structure of it. And then next to that, if
17 you take a look at this third reference that the examiner has applied, which is
18 the -- I'm sorry, the Uekane, it would be figure 7.

19 And this third reference which is the Finelli reference, figure 3 of that
20 and this fourth reference, this Kozuki, figure 2 of that, lay them all out side
21 by side, and one thing really does stand out which really would bolster our
22 arguments for patentability which we have made.

23 The examiner refers in figure 19 of Takahashi, talks about this
24 camcorder 201 being a removable, separable item, that sort of thing. And
25 yet -- and still there is really no teaching within that reference of the
26 removability of the camcorder from the printer. And in our specification,

1 that's one of the other features that we highlighted and attempt to capture in
2 our claims.

3 Now, with this Uekane reference -- and that would be at figure 7 of
4 that reference -- one of the things that's most interesting about this is that the
5 examiner applies a second reference for the monitor being contained in this
6 common camcorder which the examiner has admitted to be absent from
7 within this camcorder 201 of Takahashi.

8 But it turns out that looking at Uekane, taking it off the shelf, there are
9 no outside connections to be able to connect anything to that.

10 So looking at that, it is curious to us why the skilled artisan would
11 have relied upon this to make a connection to a printer when there is really
12 no electrical or physical way of connecting this particular device to a printer
13 or any other medium or any other component. This device appears to be an
14 entirely standalone device which cannot operate with any other invention.

15 JUDGE RUGGIERO: This isn't the examiner -- he's just relying on
16 Uekane for the teaching of integrating the display with the camera.

17 MR. DUTTON: That is correct. But the thing is that -- and that's a
18 key feature in the fact that this display has to be in camera, is what we're
19 talking about. It has to be in the camera. And we have to show that a
20 display within the camera can be operated from a source outside of the
21 camera, and that's what we have been trying to claim.

22 His primary reference doesn't show that. His primary reference shows
23 that this 202, as he admits, this monitor is not within this camcorder 201. So
24 that by itself would eliminate this, which is why he's relied upon Uekane.

25 JUDGE JEFFERY: Can you control the monitor, though, in
26 Takahashi from that control device? You have a monitor 202.

1 MR. DUTTON: That is correct.

2 JUDGE JEFFERY: And is there some sort of control function in that
3 reference that allows you to control that display, what's displayed on that
4 monitor?

5 MR. DUTTON: There is a control function in the printer itself and
6 there is nothing that allows you to control the monitor.

7 JUDGE JEFFERY: What's displayed on the monitor.

8 MR. DUTTON: Yeah, you would go back and control this through
9 the connections. So, I mean --

10 JUDGE JEFFERY: So we're talking about the display not being on
11 the camera itself as opposed to some external.

12 MR. DUTTON: External, yes. But the thing is that the display being
13 on the camera is something that is highly relevant to our invention because
14 we want this thing to be a component compact piece of equipment where
15 you have all of this together. Then you take a second device and marry it
16 up, and then you would have that second device as a common system to be
17 able to just function as an entire unit.

18 But the thing is that you don't -- our concept is by having not all of
19 these external wires and all of these external pieces, just being able to have it
20 as a compact integrated unit.

21 And the examiner provides pieces here. He provides pieces there of --
22 he has a connector, he has a monitor, he has a lot of things. But the problem
23 is that they don't integrate. There is always something missing in his
24 combination where you can't go from one to the other. The pieces just do
25 not overlap properly.

26 And one of the things with this Uekane is that there is no connection

1 to the outside. So we don't have a compact -- we don't have a compact
2 monitor that all works together within the same housing of the camera.

3 JUDGE RUGGIERO: I think the examiner's point is that once you
4 make the combination, the combination now has a camera with an integrated
5 display integrated into a printer housing that you can control both. I think
6 when you make a combination --

7 MR. DUTTON: That's the point he's trying to make. The point that
8 I'm trying to make is --

9 JUDGE RUGGIERO: Are you saying you wouldn't make the
10 combination?

11 MR. DUTTON: Take the Uekane camera. It's sitting on the shelf at
12 Best Buy and you buy it and you try to integrate it with this Takahashi
13 system, you have no connections to do that. So there is no way of getting
14 the signals in with this reference.

15 Had this reference shown something like a connection to an outside
16 source or something like that, then I think that the examiner would have
17 been in a much stronger position where there are control signals coming out
18 of this reference.

19 There are no control signals coming out of this reference. So how are
20 you going to get it into there? We don't have a situation where you can
21 control this Uekane camera externally.

22 The only way you can do it is by using the operation buttons and
23 controls that are on the rear of that panel. And the thing about it is that all of
24 the other two additional references have that same problem when you look at
25 it closely.

26 JUDGE JEFFERY: Counsel, I want to ask you a question. Going

1 back to the base reference, the Takahashi reference, something was made
2 about the nonremovability of the camera from the printer, and we have a
3 data bus there at 428.

4 My question to you is, why wouldn't it be obvious to the skilled
5 artisan to provide a connector in that data bus path so that I could just
6 provide such a removability? Wouldn't that be apparent to the skilled
7 artisan?

8 MR. DUTTON: There is no teaching in Takahashi for that particular
9 feature.

10 JUDGE JEFFERY: It may not be in the four corners of the document.
11 But let's say I don't want to haul a printer around with me every time I take
12 my camcorder to use it. I just want to use the camcorder. Wouldn't it be
13 apparent -- why wouldn't it be obvious to provide a connection?

14 MR. DUTTON: There is a simple reason for that. I was reading
15 Takahashi and I was trying to figure something out with this reference. And
16 it was quite interesting to me.

17 All of the controls that they have and all of the discussion about the
18 operability of this particular camera and the system deals with that
19 combination of the printer and the camera itself. It talks about how the
20 printer is going to operate the camera.

21 I haven't found -- or if there is in there, I haven't seen it -- the
22 discussion where this camera is operating apart from the camera. So
23 because of that, if you remove that cable, there is a question whether or not
24 201 would even function at all. No timing, no signals, no control, no data.
25 Nothing. You break the communications link.

26 JUDGE RUGGIERO: But isn't it reasonable to conclude that a

1 camcorder is -- you know, you can carry it around, you can use it. Isn't that
2 reasonable to -- a natural --

3 MR. DUTTON: What controls it?

4 JUDGE RUGGIERO: The controls in the camcorder itself.

5 MR. DUTTON: There are none there listed. All of his controls are
6 coming from the printer. All of his controls are coming from the printer.
7 And the camcorder that he lists in his prior art in the first part of this
8 reference up in figure 1, that's just merely putting out an analog signal.
9 That's all.

10 So the question is, how do you control this thing? And so there is a
11 problem there. And then all of his other references, you don't have the
12 controls coming out of it.

13 One of the interesting things about this thing, too, because the
14 examiner talks about this Finelli reference here for the connections. This
15 one here is kind of interesting especially when you look at figure 3 of Finelli
16 against figure 7 of Uekane.

17 What these two appear to be, see, the examiner says, Well, you have
18 this printer here in Finelli. You've got this connector here to a printer from a
19 camera in Finelli. Therefore, it meets this thing that you were talking about
20 of connectability.

21 But the thing is -- is that looking at this reference here, it appears to
22 me that all that Finelli is is the same thing that Uekane is, which is basically
23 a camera.

24 Looking at Finelli, it has a camera portion and then it has a second
25 portion in a separate housing that's in a monitor. Uekane has a camera
26 portion and it has a separate portion that is in a monitor -- I mean, that where

1 its monitor is in a separate portion.

2 So the thing is -- is that the examiner says that Uekane is a camcorder.

3 By analogy it seems to me that Finelli should also be that same camcorder
4 since all the same components are in Finelli which are in Uekane.

5 The only difference is that this Finelli has a display -- I mean, the
6 capability of printing in the same housing where you have the monitor. But
7 our claims require that the display be somewhere else other than within the
8 printer. So there is still a problem with that.

9 Now, the other thing is that with this Finelli reference, looking at it, it
10 has this piece on the side here which is of the monitor itself which is
11 basically a memory or memory stick or something like that. But it doesn't
12 have controls. This is just data. So there is no way of controlling this
13 camera externally. Just like the Uekane reference, there is no way of doing
14 it.

15 And the same thing holds true for this Kozuki reference here where
16 you have the individual components. One of the components of that and
17 looking at figure 2 of Kozuki is that you've got this camera that's married to
18 the tape recorder.

19 All that that is, to me, close to figure 7 of Uekane. Again, there are no
20 controls coming out of that. It's just a camera. That's all that it is. It's not a
21 system where you have the printer, where you have controls, where you
22 have things from outside coming in to operate the equipment.

23 If I bought any of these pieces of equipment off the shelf, they will
24 not work with this particular Takahashi system. It would not work because
25 there are no ways that you would be able to control the camera from an
26 external source.

1 And that's basically all I wanted to say about these references. The
2 rest of it is in the brief and so forth. I don't want to waste the time saying
3 stuff that's already there.

4 JUDGE RUGGIERO: Couple things. I noticed there is a prior
5 decision, prior board decision in this application. Is there some reason why
6 you didn't mention that?

7 MR. DUTTON: I didn't? My apologies if I didn't. I should have.
8 That is definitely my oversight.

9 JUDGE RUGGIERO: And the second thing is in the reply brief --
10 well, first of all, in your principal brief you laid out some claim groupings
11 and directed your arguments in accordance to that claim grouping. When
12 you got to the reply brief, you started arguing some of the dependent claims
13 which were never argued before. Is there some reason why we should be
14 considering those?

15 MR. DUTTON: I mean, probably the principal argument would go
16 towards the combination and that would affect the base claim.

17 But I guess definitely if the board's wisdom finds that there has been
18 something there that wasn't right, it's just that I prepared it and I kind of go
19 crazy from time to time when I see things and I would rather put it out there
20 as opposed to not say it because if you don't say it, you waive it and that sort
21 of thing.

22 JUDGE RUGGIERO: Thanks.

23 MR. DUTTON: Thank you very much.

24 (Whereupon, the proceedings at 11:04 a.m. were concluded.)